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REMARKSSummary of the Office Action

Claims 10-12, 14-19, and 21-23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirayama et al. (U.S. Patent No. 6,128,434) in view of Kameo et al. (U.S. Patent No. 4,899,370).

Claims 24-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirayama et al. in view of Kameo et al. and further in view of Yuen et al. (U.S. Patent No. 5,488,409).

Summary of the Response to the Office Action

Applicants have amended claims 10, 14, 17, and 21. No new matter has been added. Accordingly, claims 10-12, 14-19, and 21-31 are pending for consideration.

The Rejection under 35 U.S.C. § 103(a)

Claims 10-12, 14-19, and 21-23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirayama et al. in view of Kameo et al. Claims 24-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hirayama et al. in view of Kameo et al. and further in view of Yuen et al. To the extent that this rejection might still apply to the claims as newly amended, Applicants respectfully traverse the rejection for at least the following reasons.

With respect to the rejection of independent claims 10, 14, 17, and 21 under 35 U.S.C. § 103(a), Applicants respectfully submit that the applied references do not teach

or suggest each and every element of independent claims 10, 14, 17, and 21, as newly-amended. Independent claims 10, 14, 17, and 21 recite, *inter alia*, "a recordable optical medium in which a record information can be recorded by a recording apparatus." At least this feature is neither taught nor suggested by the applied references.

Page 2 of the Office Action dated March 14, 2003, indicates that optical disk 100 in Fig. 1 of Hirayama et al. discloses "a recording medium." However, optical disk 100 is not used for recording. Hirayama et al. fails to disclose an apparatus that records data on optical disk 100. Therefore, the optical disk 100 of Hirayama et al. is a read-only disk and the information recorded in the management area and data area is used for reproducing and not for recording. Hence, the applied references fail to teach or suggest "a recordable optical medium in which a record information can be recorded by a recording apparatus," as recited in independent claims 10, 14, 17, and 21.

Furthermore, the applied references fail to teach or suggest recording record information "based on the reservation information," as recited in independent claims 10, 14, 17, and 21. Page 5 of the Office Action states that Hirayama et al. discloses "reservation information" that identifies a program recorded in the disk which is used to reproduce the program. Applicants disagree with this characterization of Hirayama et al. In fact, according to Hirayama et al. "reservation" means that the next program to be reproduced is reserved. In contrast, in certain embodiments of the present invention, "reservation" means that a television program is recorded at a scheduled time. For example, record information is recorded on a recordable optical medium according to reservation information recorded on the recordable optical medium. That is, the

recording apparatus reads the reservation information from the recordable optical medium, and records the record information on the recordable optical medium based on the reservation information. Hence, the applied references fail to teach or suggest recording record information "based on the reservation information," as recited in independent claims 10, 14, 17, and 21.

Moreover, the applied references fail to teach or suggest reservation information "copied from the recording apparatus," as recited in independent claims 10 and 14. The reservation information exists on the recordable optical medium and in the recording apparatus. In contrast, Hirayama et al. discloses a read-only disk for reproducing multilingual information. As such, the applied references fail to teach or suggest reservation information "copied from the recording apparatus," as recited in independent claims 10 and 14.

For at least these reasons, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because the applied references do not teach or suggest each feature of independent claims 10, 14, 17, and 21. Furthermore, Applicants respectfully assert that dependent claims 11, 12, 15, 16, 18, 19, and 22-31 are allowable at least because of their dependence from their respective independent claims and the reasons set forth above.

Finally, in regard to the rejection of independent claims 10, 14, 17 and 21 under 35 U.S.C. § 103(a), Applicants respectfully submit that no *prima facie* case of obviousness has been established. To establish a *prima facie* case of obviousness, the Office must show that there is "some suggestion or motivation, either in the references,

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See M.P.E.P. § 2143.01. In other words the suggestion or motivation must be found in the prior art. Also, "there must be a reasonable expectation of success." *Id.* at § 2143.03. Namely, there must be some degree of predictability that the modification would be successful.

The Office Action indicates that Kameo et al. discloses a videotape recorder having a timer reservation function. However, Kameo et al. does not teach or suggest reservation information that indicates a scheduled time to record on the videotape. In Kameo et al., reservation information is merely stored in the memory of the videotape recorder and is not recorded on the recordable optical medium. As noted above, Hirayama et al. discloses a read-only disk for reproducing multilingual information. Applicants note that the applied references do not provide any motivation to combine the read-only disk of Hirayama et al. with the timer reservation function of Kameo et al.

Nevertheless, the Office Action states that modifying Hirayama et al. with the timer reservation function taught by Kameo et al. provides the desirable advantage of recording a television program. However, the read-only disk of Hirayama et al. is not used for recording. Hence, the Office Action fails to provide some suggestion or motivation to modify the teachings of Hirayama et al. in view of Kameo et al.

Indeed, the Office Action fails to provide any suggestion or motivation to combine the read-only disk of Hirayama et al. with a videotape recorder of Kameo et al. The Office Action states that the reservation information of Hirayama et al. is information that identifies a program recorded on the disk which is used to reproduce a

program. As such, Applicants respectfully request that the Examiner explain how Hirayama et al. is to be modified by the teachings of Kameo et al. In other words, how a technique for recording is used in a reproducing technique. Moreover, if the reservation information taught by Kameo et al. is recorded on the read-only disk disclosed by Hirayama et al., the modification would render the device disclosed in Hirayama et al. inoperable for its intended purposes. *Id.* at §2143.01. Therefore, the Office Action fails to provide any suggestion or motivation to modify the teachings of Hirayama et al. in view of Kameo et al.

For at least these reasons, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn because the Office Action fails to establish a *prima facie* case of obviousness. Furthermore, Applicants respectfully assert that dependent claims 11, 12, 15, 16, 18, 19, and 22-31 are allowable at least because of their dependence from their respective independent claims and the reasons set forth above.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this Amendment, the Examiner is invited to contact Applicants' undersigned representative at 202.739.5271 to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency

FROM MORGAN, LEWIS & BOCKIUS

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ATTORNEY DOCUMENT NO. 09/266,780

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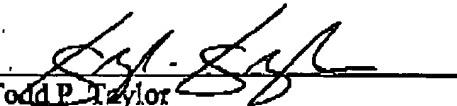
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of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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